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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/005,873      | 12/07/2001  | Gordon K. Whitney    | 28689-189           | 7964             |

7590 02/18/2003

MCDERMOTT, WILL & EMERY  
600 13th Street, N.W.  
Washington, DC 20005-3096

EXAMINER

SHERER, CURTIS EDWARD

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1761

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DATE MAILED: 02/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/005,873

Applicant(s)

WHITNEY ET AL.

Examiner

Curtis E. Sherrer

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1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/07/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because there is no antecedent basis for the phrase "the water-leaf mixture" or "step 3."

Claim 2 is indefinite because there is no antecedent basis for the "the aqueous extract."

Claim 4 is indefinite because the scope of the phrase "about" is unknown.

Claim 4 is indefinite because claim 1 does not refer to chopped leaves.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steinkraus (Indigenous Fermented Foods, pp.389-97) in view of Applicants' admissions (pages 1-6).

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Steinkraus teaches the production of pulque. It is the national drink of Mexico and is produced by fermenting the juice of *Agave*, mainly *A. atrovirens* or *A. americana*.” (page 389). On page 392, it is stated that fermentations can be conducted with pure yeast cultures to produce a final product in 2 to 3 days. On page 394, the sugar content of the leaves is discussed. He cites to recent improvements in the production of pulque whereby “the whole agave plant, including stems and leaves” are mechanically pressed. (Page 397). Also, “concentrated *Agave* syrup [is] being distributed to manufacturers in order to shorten the fermentation and improve the quality of the product.” (Id.).

Steinkraus does not specifically teach the one of the *Agave* plants can be blue agave; that nutrients are added to the fermentation or that the leaves are macerated. Applicants admit that blue agave is a well known source of sugar for alcohol production. They admit that producers typically add “chemical to accelerate yeast growth so that fermentation results in a more robust body.” (Pages 5-6). They also admit that producers typically mash the agave plant (pinas) “to separate the pulp from the juice.” (Page 5). Applicants also admit that in “recent years, however, the blue agave plant has become in short supply. . . . Accordingly there is a need to increase the production of tequila from the present resources.” (Page 3).

It would have been obvious to those of ordinary skill in the art to use the blue agave leaves as a source of sugar to produce alcoholic beverages because, as stated by applicants, the agave plant is becoming scarce and further, those in the beverage art are always trying to produce new and different products to fulfill consumer demand. The well known method of mashing, involving the addition of water, to a solid starch material, such as agave, is notoriously well known and therefore it would have been obvious to those of ordinary skill in the art to do

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that which is commonly practiced in the art. Lastly, it would have been obvious to those of ordinary skill in the art to use the claimed fermentation additives, as they are notoriously well known and used in the fermentation art for the reasons set forth above, e.g., they accelerate the fermentation.

Applicants' attention is invited to *In re Levin*, 84 U.S.P.Q. 232 and the cases cited therein, which are considered in point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected, and useful function. *In re Benjamin D. White*, 17 C.C.P.A (Patents) 956, 39 F.2d 974, 5 U.S.P.Q. 267; *In re Mason et al.*, 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 U.S.P.Q. 221.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lewis ([www.foodline.com/articles.bars.asp?article=35](http://www.foodline.com/articles.bars.asp?article=35)) teaches that mezcal is a twice-distilled beverage made from pulque. Pulque is produced from agave leaves that are buried in pits with red, hot rocks and thereafter mashed and fermented. (Third para.)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis E. Sherrer whose telephone number is 703-308-3847. The examiner can normally be reached on Tuesday-Friday, 8AM-6:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3602 for regular communications and 703-305-3602 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

A handwritten signature in black ink, appearing to read "Curtis E. Sherrer". The signature is fluid and cursive, with a horizontal line extending from the end.

Curtis E. Sherrer  
Primary Examiner  
February 5, 2003